



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/554,315 11/08/95 MAHN

SAF-41-111

D3M1/1125

GREGORY J LUNN
WOOD HERRON AND EVANS
2700 CAREW TOWER
CINCINNATI OH 45202

EXAMINER

DIXON, M

ART UNIT

PAPER NUMBER

1317

DATE MAILED: 11/25/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 8-30-96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 6-10 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 6-10 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with Informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

15.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1317.

16.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

17.

Claims 6-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Powers et al ('984) in view of Mahn, jr ('783) for reasons as set forth in the previous office action, *inter alia*.

18.

Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over Mahn('783) for reasons as set forth in the previous office action, *inter alia*.

19.

Applicant's arguments filed 8-30-96 have been fully considered but they are not deemed to be persuasive. Applicants argue that 1) the Powers reference contains reversed numerals 10 and 12. To this the examiner respond by reminding applicants that no modification of the cited references for any purposes are considered appropriate. Applicants argue that 2) " Mahn reference does not show cut lines through the heat-activated adhesive layer and the adhesive layer, but not through the support layer ". The examiner is not sure about applicants's contention and accordingly will reserve any related comments. Applicants argue that 3) if one were to incorporate cut lines in the Powers reference, the reference would not function in the same manner as applicants's invention. To this the examiner wishes to remind applicants that the office is in no position to determine experimentally whether or not, in an article such as that at issue, the subject matter claimed is the same as that known in the prior art. Accordingly, in such instances, this shifts the burden to the applicants who have the resources to make a clear distinction and to better experimentally define the difference between the obvious teachings of the references and the claimed

Serial Number: 08/554315
Art Unit: 1317

-4-

invention. Applicants finally argue that 4) there is no disclosure or suggestion in the Mahn reference to bond a continuous heat-activated laminate to a support layer and then cut it while it is on the support layer. The examiner would disagree and point applicant to col 3, lines 59-65 and col 3, lines 45-53 of said patent.

20.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

21.

Crystal Mall 1 Fax Center

A facsimile center has been established in Crystal Mall 1. The hours of operations are Monday through Friday, 8:45 AM to 4:45

Serial Number: 08/554315
Art Unit: 1317

-5-

PM. This new location should be used in all instances when faxing any correspondence to Group 1300. The Patent Examining Fax Center new telecopier number is (703) 305-5436. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

22.

Any inquiry concerning this communication should be directed to Merrick Dixon at telephone number (703) 308-0013.



Merrick Dixon

Primary Examiner

Group 1300